

## **REMARKS/ARGUMENTS**

### **Status of Claims**

Claims 1 to 4, 6 to 8, 12 to 14, 16 and 19 to 24 are pending in the application. Claims 11 and 18 have been cancelled from the application.

### **Amendments for the Claims**

Claim 1 has been amended to incorporate the subject matter of claim 11. Claim 12 has been amended to incorporate the subject matter of claim 18. Claims 21 and 24 have been amended to incorporate the subject matter of claim 18.

### **35 U.S.C. § 103 Claim Rejections**

In rejecting claims under 35 U.S.C. § 103(a), the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d, 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. Additionally, in making a rejection under 35 U.S.C. § 103(a) on the basis of obviousness, the Examiner must provide some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *See Oetiker*, 977 F.2d at 1445. *See also Piasecki*, 745 F.2d at 1472. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445; *Piasecki*, 745 F.2d at 1472.

Applicant's analysis below demonstrates that the Examiner has failed to fulfil the initial burden for a finding of obviousness under 35 U.S.C. 103.

Claims 1 to 3, 6 to 8, 11 to 14, 16 and 18 to 24 are all rejected under 35 U.S.C. 103(a) as being unpatentable having regard to Noel et al. (Noel), U.S. Publication No. 2005/003259 in view of Forssell et al. (Forssell), U.S. Patent No. 6,671,511.

Claims 11 and 18 have been cancelled from the application, rendering the objection to those claims moot.

However, as the Examiner has rejected claims 11 and 18, and the subject matter of claims 11 and 18 has been incorporated into claims 1 and 12, Applicant will argue the rejection of claims 1 and 12 in view of the rejection of claims 11 and 18.

Applicant submits that amended claims 1, 12, 21 and 24, and claims dependent upon them, are patentable over Noel and Forssell, as the Examiner has not properly determined the differences between the claimed invention and the prior art. Furthermore, the Examiner has not provided a valid explanation to support an obviousness rejection under 35 U.S.C. 103. Applicant's reasoning is detailed below.

***Differences between the claimed invention and the prior art***

The following is a discussion of why the cited references do not disclose all the elements of the rejected claims. While it may be considered that “the mere existence of differences between prior art and an invention does not establish the invention's non-obviousness”, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one skilled in the art (Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of the Supreme Court Decision in *KSR international Co. v. Teleflex Inc.*, published in Federal Register Vol. 72, No. 195, October 10, 2007). As such, if elements from a claim are not disclosed by the combination of cited references and no valid reasoning is provided why the missing elements would be obvious, this may provide a strong basis for why a claim should not be rejected based on obviousness.

On page 9 of the Final Office Action dated January 6, 2009, the Examiner has alleged that Noel discloses “wherein the extended functionality comprises at least one functionality selected from the group consisting of: a) registering a continuing transmit channel request at the

THD device b) canceling a transmit channel request at the THD device; and c) performing automatic release of the transmit channel by the THD device” in the form of “if the priority level is a higher priority than that of the current speaker then the message is sent to each mobile device indicating a change of speaker is set to occur. The requestor is granted the ability to speak [0022]”.

Applicant respectfully submits that Noel does not perform any of the extended functionality recited in amended claims 1 and 12, formerly the subject matter recited in claims 11 and 18. Applicant directs the Examiner’s attention to page 16 line 20 to page 17 line 19 of the present application for a more detailed example of what is intended by “extended functionality” and “non-extended functionality”. This section of the application describes an example of four qualifier flags, one of which has a value for “non-extended functionality”, namely “Flag value 1 – RHD making talk channel request”, and three extended functionality qualifier flag values that correspond to the functionalities a) to c) in amended claims 1 and 12. Applicant submits that Noel does not suggest any of the extended functionality described in amended claims 1 and 12. Therefore, even if one were to consider that Forssell discloses a qualifier flag as recited in claims 1 and 12, which Applicant does not concede, Applicant submits that Noel does not disclose any type of “extended functionality” that may be indicated by the use of a qualifier flag.

For at least the reasons discussed above, Applicant respectfully submits that the combination of Noel and Forssell does not teach all the limitations recited in amend claims 1 and 12. Furthermore, the Examiner has failed to explain why the missing limitations would be obvious to one skilled in the art. Without all the limitations of claims 1 and 12 being disclosed by the two references and no reason provided by the Examiner why these missing limitations would be obvious, Applicant submits that there are differences between what is recited in amended claims 1 and 12 and what is disclosed in the cited art that renders the claims non-obvious.

***Reason to Combine***

Once the scope of the prior art is ascertained, the content of the prior art must be properly combined. An obviousness inquiry requires a review of a number of factors, including the background knowledge possessed by a person having ordinary skill in the art, to determine whether there was an apparent reason to combine the elements of the prior art in the fashion claimed by the present invention. For the Patent Office to combine references in support of an obviousness rejection, the Patent Office must identify a reason why a person of ordinary skill in the art would have combined the references *KSR Int'l v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S., Apr. 30, 2007), Id. at 15. Even if the Patent Office is able to articulate and support a suggestion to combine the references, it is impermissible to pick and choose elements from the prior art while using the application as a template.

Applicant submits that there is no suggestion of a desirability of the claimed invention in the references that would serve as a reason for one skilled in the art to combine the references.

The Examiner's motivation for combining Forssell and Noel is tied to a view that Noel and Forssell teach the particular limitations of claims 1 and 12. As detailed above in view of the amendments to claims 1 and 12, this is an incorrect interpretation of the references and as such this also affects the Examiner's reason for combining the cited references.

The Examiner alleges that "[a]t the time of the invention, it would have been obvious to a person of ordinary skill in the art to transfer information (Forssell) allowing efficient and organized queuing of call participants (Noel)". Even if what is disclosed in Forssell were to be considered equivalent to the specific limitation of claims 1 and 12 to which it is being equated, which Applicant does not concede, Applicant submits that without a suitable reason, the combination of references is improper. There is no reason to combine Forssell with Noel. Forssell is concerned with the problem of how to transfer delay sensitive data in a packet radio service. This is unrelated to the problem of Noel of how a call originator can control who speaks in a half-duplex call.

In the Response to Arguments section on page 5 of the final Office Action, the Examiner alleges that Forssell discloses receiving a qualifier flag and performing extended functionality in

response to a value of the qualifier flag. Even if Forssell did disclose such limitations, which Applicant does not concede, such activities occur between a mobile station and a network to which the mobile station is connected to. The network is not the same as a second user device recited in present claim 1. Applicant submits that the network would be more analogous to the PPT server 140 of Noel in that it is an intermediary between a first user device and a second user device. The Examiner has failed to provide evidence why one skilled in the art would equate the network in Forssell with the mobile device of the participant who is currently speaking, and not the more logical choice of the PTT server in Noel in a proposed combination of Noel and Forssell. Without evidence as to why one skilled in the art would make the choice to modify the system of Noel with the subject matter identified by the Examiner in Forssell in a manner that is opposed to the logical choice of modifying the PTT server as the intermediary node in the network, which is equivalent to the network in Forssell, Applicant submits that the Examiner has failed to provide sufficient evidence for a suitable reason for combining the references.

Furthermore, in the Response to Arguments section on page 5 of the final Office Action, the Examiner responds to Applicant's previous arguments that there is no suggestion to combine references by stating that "the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claims invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art". The Examiner follows this statement by simply arguing that "it would have been obvious to a person of ordinary skill in the art to transfer information in a packet radio service allowing sufficient radio resources for the mobile station (Forssell) further allowing for an organized and efficient call (Noel)". Yet the Examiner provides no reason why such a combination would be obvious, other than saying it would be. Applicant submits that such a position does not fully support a *prime facie* case of obviousness, especially in view of Applicant's comments submitted above.

The Examiner also suggests that Noel and Forssell are "in a similar field of endeavour". Other than Noel and Forssell disclosing wireless communications, the Examiner has not provided sufficient evidence that the two references are in "a similar field of endeavour". Applicant submits, as mentioned above, that Forssell is concerned with the problem of how to

transfer delay sensitive data in a packet radio service. This is unrelated to the problem of Noel of how a call originator can control who speaks in a half-duplex call.

In the Advisory Action dated March 23, 2009, the Examiner respectfully disagrees with the arguments presented above. The Examiner states at the bottom of page 3 and top of page 4 of the Advisory Action that Noel's disclosure of "If the call participant is not granted the ability to speak, that is transmit her speech to the others, then the caller is placed in the queue to await her turn based on the assigned priority level (**the TCRM including a qualifier flag (participant's identity qualifying them to participate in the call) further used by the second user device (current speaker) for performing extended functionality (allowing the participant to speak) in response to a value (priority level representing the participant's relative importance) of the qualifier flag (participant's identity)**)". Applicant submits that the qualifier flag is different than just the participant's identity, as alleged by the Examiner, especially in view of the earlier recitation in the claims of the participant's identity being specifically the participant's identity, which is different than a qualifier flag, recited later in the claim. The participant's identity cannot be equivalent to both the identity and a qualifier flag, when the two are clearly different limitations recited in the claim.

The Examiner then states on page 4 that Forssell discloses the "concept or idea" of including a qualifier flag. However, as discussed above, even if one were to consider that Forssell discloses a qualifier flag as recited in claims 1 and 12, which Applicant does not concede, Applicant submits that Noel does not disclose any type of "extended functionality" that may be indicated by the use of a qualifier flag. Therefore, Applicant maintains that the Examiner has mischaracterized the prior art, and as such the reasons for combining the references is called into question.

Applicant further submits that Forssell is directed for use in an uplink direction from a mobile device to a network (col. 9, lines 20-29 of Forssell), not a downlink direction from a network to a mobile device, as recited in the claims of the present application and disclosed in Noel (paragraph [0022] of Noel). Therefore, Applicant submits that Forssell teaches away from the intended uses of downlink communications disclosed in Noel, and therefore one skilled in the art would not consider combining Forssell and Noel.

Furthermore, as discussed above Applicant submits that Forssell is directed to dealing with delay sensitive data, such as speech and video data and not directed to selection of speakers based on user based priority, as is disclosed in Noel. As the two references are directed to different areas of communications, i.e. delay sensitive data and user based priority, Applicant submits that this is another reason why there is a lack of reason to combine the references in the manner alleged by the Examiner.

For at least the above reasons, Applicant submits that the Examiner has failed to provide a suitable reason for combining the references.

In view of the foregoing, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness and that claims 1 and 12 of the present application is patentable over Noel and Forssell. Applicant respectfully requests the Examiner reconsider and withdraw the obviousness rejection of claims 1 and 12.

Claims 2, 3 and 6 to 8 depend from claim 1, either directly or indirectly. Claims 13, 14, 16, 19 to 20, 22 and 23 depend directly or indirectly from device claim 12. Claims 21 and 24 recite similar subject matter to claims 1 and 12 and have been amended to include the same limitation added to amended claims 1 and 12.

For at least the reasons discussed above concerning the rejection of claims 1 and 12, Applicant submits that claims 2, 3, 6 to 8, 13, 14, 16 and 19 to 24 patentably distinguish over the combination of Noel and Forssell.

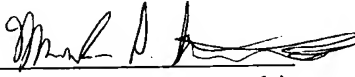
The Examiner has rejected claim 4 under 35 U.S.C. 103(a) as being unpatentable over Noel and Forssell in view of Stubbs, U.S. Patent No. 6,930,994.

The Examiner points to Stubbs as teaching wherein the half-duplex session is a voice communication session compliant with at least one system selected from the group of iDEN.TM., 1XRTT CDMA, GSM/GPRS, UMTS, and TDMA. Claim 4 depends from claim 1. Even if Stubbs teaches what is alleged by the Examiner, Stubbs does not overcome the deficiencies of the combination of Noel and Forssell outlined above concerning the rejection of claim 1. Accordingly, the combination of Noel and Stubbs does not render claim 4 obvious.

In view of the foregoing, early favorable consideration of this application is earnestly solicited. In the event that the Examiner has concerns regarding the present response, the Examiner is encouraged to contact the undersigned at the telephone number listed below.

Respectfully submitted,

RAO, KRISHINA ET AL.

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